

REMARKS

Applicants respectfully request reconsideration of the claim rejections set forth in the Office communication dated March 22, 2007.

Summary

Claim 11 and 20 are currently amended.

Claim 17 is cancelled.

Claim 25 is added. No new matter has been added as a result.

Claims 11 – 16 and 18 – 25 are currently pending.

Summary of Interview

Applicants thank the primary Examiner, Lawrence Ferguson, and supervising Examiner, Milton Cano for the telephonic interview dated 9 August 2007. During the interview, the Applicants' Agent and the Examiners discussed the remaining claim rejections, which were maintained in the Advisory Action dated June 13, 2007. The only remaining claim rejections are pursuant to 35 U.S.C. § 112, first and second paragraph. During the interview, Examiner Cano suggested that Applicants define the first material. Examiner Cano kindly suggested amending the claims to include language such as: the first material being such that... Examiner Cano agreed to review a set of proposed claim amendments. Applicants' Agent faxed three (3) proposed claim amendments to Examiner Ferguson on 13 August 2007. No agreement was reached at the time this Response was filed.

Allowable Subject Matter

Claim 17 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 11 was amended to incorporate the allowable features of claim 17. Therefore, claim 11 should be allowable for at least this reason.

Claim Rejections – 35 U.S.C. § 112, first paragraph

Claims 11 – 24 were rejected pursuant to 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 11 recites a method for verifying the authenticity of a coupon comprising, *inter alia*, providing, on or within the coupon, a first material having a lower starch content than non-currency grade paper forming the coupon.

The Examiner stated: “it remains unclear as to how much starch content is found in non-currency grade paper. This information is essential in determining how much starch content is found in the first material, based upon instant claim 11” (Office action dated March 22, 2007; page 7). Applicants respectfully disagree. Claim 11 defines a relationship between the coupon and the first material. The amount of starch content of the non-currency grade paper is relative to the starch content of the first material. Thus, an exact amount of starch content is not needed. For example, if the starch content of the non-currency grade paper is “x” then the starch content of the first material is less than “x.” The claim language is broad, but definite. Claim 11 strikes a definite relationship between the amount of starch content of the non-currency grade paper and the starch content of the first material.

During the interview dated 9 August 2007, the Examiners suggested providing the amount of starch included or not included in the first material. The Examiners maintained that it is unclear how much starch is in non-currency grade paper. Although Applicants believe that a specific amount of starch content is irrelevant for claim 25, Applicants respectfully submit that one skilled in the art would understand that (1) non-currency grade paper includes starch and (2) currency grade paper does NOT include starch. As support for these conclusions, Applicants submit several references. These references are made of formal record in an Information Disclosure Statement (IDS) being filed with this Response and are identified by the PTO form 1449 reference number.

Reference B1 states: “[G]enuine paper currency does not contain starch” (col. 2, lines 58 – 59).“ Counterfeit currency which will probably contain starch” (col. 2, lines 60 – 61). “In the teachings of U.S. Pat. No. 5,063,163 an attempt has been made to provide a method of detecting counterfeit currency by assessing crudely the relative amounts of starch as a component of the paper used in the production of currency. As paper used in genuine currency is known to contain less sizing in form of starch while just the opposite is the case with regard to paper employed in the printing of counterfeit currency” (col. 1, lines 26 – 34).

Reference B2 states: “[T]he genuine paper currency, either does not contain any starch or its content is chemically untraceable” (col. 2, lines 49 – 53).

Reference B3 states: “Writing and copy papers contain starch to make them crisp and smooth... U.S. currency does not contain any starch” (page 1; lines 8 – 10).

Reference B4 states: “There are no wood fibers or starch in currency paper” (page 1; lines 10 – 11).

Reference B5 states: “No starch or clay agents are employed in currency paper, although these are added to most other high-quality papers to improve brightness” (page 1, lines 27 – 29).

Reference B6 states: “Iodine reacts with starch, which is found in wood-based paper but not in genuine currency paper” (page 2; lines 20 – 21).

Reference B7 states: “Starch utilization in papermaking depends on the type of paper, other raw materials used, papermaking technology, desired end properties, and paper machine productivity needs. For example, tissue grades typically use low amounts of starch or no starch while fine printing and writing papers can use up to 10% starch by paper weigh. A higher amount of starch is used in paper grades containing

higher mineral fillers to maintain strength and printing properties” (page 1; lines 30 – 37).

Reference B8 states: “Students should see that only standard paper contains starch” (page 1, line 11).

Reference B9 states: “The history of starch in papermaking is 6000 years old – as old as the printed word itself. Starch is used in papermaking from the wet end to the size press” (page 1; lines 2 – 5).

Reference B10 states: “Currency paper is a highly specialized product that includes cotton and linen fibers” (page 5; lines 31 – 33)

These references are illustrative of the submission that one skilled in the art would understand that non-currency grade paper includes starch and currency grade paper does not include starch. Therefore, claim 11 is fully enabled by the specification.

The Examiner also stated: “Neither the instant claims or specification teaches how much starch content is in non-currency grade paper, which makes it difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed” (Office action dated March 22, 2007; page 2). Applicants respectfully disagree. Both the claims and specification teach the starch content of the non-currency grade paper is higher than the starch content of the first material. This clearly defines a structural difference between the first material and the non-currency grade paper. One skilled in the art can simply compare the starch content of non-currency grade paper to the starch content of the first material. Even if it were difficult to make this comparison, MPEP 2164.01 merely requires “the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” Applicants submit that determining whether the starch content of the first material is lower than the starch content of the coupon would not require undue experimentation for one skilled in the art.

The Examiner argues that not knowing the starch content of the non-currency grade paper “makes it difficult to determine a lower starch amount in the first material.” However, MPEP 2164.01 states that “the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.” Cited references 6,214,766 and 5,063,163 illustrate that it is common in the art to make a distinction between starch content in paper. Non-currency grade paper clearly includes substantial or detectable amounts of starch. A person of ordinary skill in the art knows non-currency grade paper includes starch, so would understand a material having lower starch content. Even if the determination is difficult, it is not undue because it is common in the art. MPEP 2164.01 also states that “the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue.” Applicants submit that the Examiner has not adequately set out that the comparison of starch content is undue.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 11 – 24 were rejected pursuant to 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 11 recites comparative starch content, not an absolute content. Therefore, claims 11 – 24 point out the claimed subject matter.

Claim Rejections

Claims 11 – 16 and 18 – 23 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Collings (U.S. Patent No. 5,188,871). Claims 11 – 14, 16, and 18 – 23 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Ahlm, Jr. et al. (U.S. Patent 3,001,887). Claim 24 was rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Collings in view of Kurrle (U.S. Patent No. 6,214,766). Claim 24 was rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Ahlm, Jr. et al. in view of Kurrle.

Claim 11 was amended to incorporate features recited in allowable claim 17. As stated by the Examiner: "The closest prior art does not teach or suggest the recited method further including determining that the coupon is authentic when a light mark results from applying a chemical to the coupon and not authentic when a dark mark results from applying a chemical to the coupon" (Office action dated March 22, 2007; page 7). Therefore, claim 11 is allowable over the cited references for at least the same reasons that claim 17 is allowable over the cited references.

Dependent claims 12 – 16 and 18 – 19 depend from allowable claim 11, so are allowable for at least this reason.

Claim 20 recites, *inter alia*, a light color change indicates that the coupon is authentic and a dark color change indicates that the coupon is not authentic. Claim 20 recites features that are similar to the allowable features of claim 11. Therefore, claim 20 is allowable for at least this reason.

Dependent claims 21 – 24 depend from allowable claim 20, so are allowable for at least this reason.

New Claim 25

Claim 25 was added. No new matter was added as a result. Claim 25 includes the allowable features recited in previously allowed claim 17, so is allowable for at least this reason. Claim 25 is fully enabled and is definite. Claim 25 clearly points out and defines the claimed subject matter.

During the telephonic interview dated 9 August 2007, Examiner Cano requested that the Applicants define the amount of starch in the first material. Claim 25 recites a first material being free of or substantially free of starch, the coupon having a higher starch content than the first material. Claim 25 defines the amount of starch content in the first material. The amount of starch content in the first material is zero or substantially zero. Claim 25 clearly recites that the starch content of the coupon is higher than the starch content of the first material. One skilled in the art would

understand that claim 25 recites that the starch content of the coupon is greater than zero or substantially zero. As requested by the Examiners, both the amount of starch in the first material and the coupon is clearly defined. Therefore, claim 25 is definite for at least this reason.


Claim 25 also recites the first material being such that the chemical generates a light mark when the coupon is authentic and a dark mark when the coupon is not authentic. Examiner Cano kindly suggested defining the first material. Examiner Cano suggested including a limitation that recited "the first being such that..." In order to expedite prosecution, Applicants have included such a limitation. Applicants have further defined the relationship and reaction between the first material and the chemical. Therefore, claim 25 is also definite for at least this reason.

CONCLUSION

For at least the reasons presented above, the Applicants respectfully submit that the pending claims are in condition for allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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